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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,926	01/24/2002	Justin F. Gaynor	M-12018 US	4011

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EXAMINER

MOORE, KARLA A

ART UNIT	PAPER NUMBER
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1763

DATE MAILED: 12/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/056,926

Applicant(s)

GAYNOR, JUSTIN F.

Examiner

Karla Moore

Art Unit

1763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) 1-7 and 22-47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-21 and 48-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 May 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 8-9, 12-14, 17 and 48-56 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,882,008 to Garza et al.

3. Garza et al. disclose a cluster tool for semiconductor processing, comprising: an ash/silylation chamber (Figure 1, 106), said ash silylation chamber configured to perform an ashing process (column 5, rows 22-37) and a silylation process (column 5, rows 16-21); and a wafer in/out chamber (Figure 1, 10), configured to introduce one or more wafers into said cluster tool.

4. With respect to the recitations based on a method to be performed using the claimed apparatus, the courts have ruled that claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959).

Further, the courts have ruled that inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims. In re Young, 75 F.2d 966, 25 USPQ 69 (CCPA 1935) (as restated in In re Otto, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)). The courts have also ruled that expressions relating the apparatus to the contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claim. Ex parte Thibault, 164 USPQ 666, 667 (Bd. App. 1969).

5. With respect to claims 9 and 12, Garza et al. disclose that the apparatus may further comprise plural process chambers similar to the chamber described above which may be an etch module (column 5, rows 39-43 and column 3, rows 42-46).

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6. With respect to claim 13, the ash/silylation chamber is also configured to perform an etch process (column 5, rows 39-43), so, that the chamber may be characterized as an etch/ash/silylation chamber as claimed.

7. With respect to claim 14, as mentioned above, the etch/ash/silylation chamber may further comprise additional processing chambers (column 3, rows 42-46).

8. With respect to claim 17, the etch/ash/silylation chamber of Garza et al. may also be characterized as an organic removal/silylation chamber, configured to remove organic sacrificial material, such as HMDS (column 5, rows 56-61).

9. With respect to claims 48-56, as mentioned above, the courts have ruled that claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). Further, the courts have ruled that inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims. In re Young, 75 F.2d 966, 25 USPQ 69 (CCPA 1935) (as restated in In re Otto, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)).

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 10-11, 15-16 and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garza et al. as applied to claims 8-9, 12-14, 17 and 48-56 above, and further in view of U.S. Patent No. 5,171,939 to Moffat.

12. Garza et al. disclose the invention substantially as claimed and as described above.

13. However, Garza et al. fail to teach a cap deposition module chosen from the group consisting of a PECVD module or a spin-on deposition module.

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14. Moffat discloses a cluster apparatus designed to perform manufacturing tasks specifically related to photoresist processing in a single, compact apparatus and including a spin-on deposition module for the purpose of depositing a photoresist layer on a wafer (abstract and column 4, rows 14 and 15).

15. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention was made to have provided a spin-on module deposition module in Garza et al. for depositing a photoresist layer as taught by Moffat.

16. With respect to the mention of specific materials in claims 17-21, the courts have ruled expressions relating the apparatus to the contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claim. *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969). In the present case, the prior art apparatus would be capable of the deposition as claimed.

#### ***Response to Arguments***

17. Applicant's arguments filed 23 October 2003 have been fully considered but they are not persuasive.

18. In response to applicant's argument that the Garza et al. reference discloses using the apparatus for a different method than that intended to be used with the presently claimed invention, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Applicant's amendments and argument fail to even suggest a structural difference exists between the prior art and the claimed invention.

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**Conclusion**

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karla Moore whose telephone number is 571.272.1440. The examiner can normally be reached on Monday-Friday, 8:30am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Mills can be reached on 571.272.1439. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
km  
26 April 2004

  
Parviz Hassanzadeh  
Primary Examiner  
Art Unit 1763